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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/975,843 | 10/12/2001 | Stephen H. Friend | 9301-161 | 1315 |
| 20583 | 7590 | 01/19/2006 | EXAMINER | |
| JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017 | | | SKIBINSKY, ANNA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1631 | |
| DATE MAILED: 01/19/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/975,843 | Applicant(s) FRIEND ET AL. | |
| | Examiner Anna Skibinsky | Art Unit 1631 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-59, 67, 68, 71, 72 and 79-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-59, 67, 68, 71, 72 and 79-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

RESPONSE TO APPLICANT

Applicants' arguments, filed on October 20, 2005, have been fully considered but they are not deemed persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Currently claims 53-59, 67, 68, 71, 72, and 79-81 are pending. Amendment to claims 53, 59, 67, 71, 79-81 are entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 53-59, 67, 68, 71, 72, and 79-81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's recitation of law in the previously filed Remarks was fully considered but the claims still lack a tangible, concrete and useful result. The tangible, concrete and useful result must be disclosed in the body of the claims and not in Applicant's arguments. Due to the verbose nature of the claims, there seems to be no tangible result as set forth by the method steps carried out by the computer system. The purpose for the calculation of protein activity (line 23 of claim 53) remains unclear,

rendering the claims as being directed toward something not tangible, concrete, or useful. The tangible, concrete, or useful result is unspecified in the intertwined body of the method steps as well as the verbose preamble. A suggestion for improving the transparency of the tangible, concrete, or useful result would be to rewrite the independent claims so that the method is disclosed in a step-by-step manner where the each independent step is clearly defined. Currently, the preambles of the independent claims contain a verbose amount of information that seem essential to the method steps but, without actually disclosing the purpose of the method.

Additionally, the claims are currently deemed non-statutory because a concrete, tangible and useful result is not provided to the user. There is not physical manipulation of the invention or a visual display that renders the invention as something manifesting in physical space. The claims are currently set forth as a manipulation of numbers and data in "computer space". There is no mention of actual hardware or visual display of data. The recitation of a computer program product, processor and memory does not qualify as statutory subject matter because said entities are not necessarily physical subjects accessible by a user. A suggestion for directing the claims toward a statutory subject matter would be to introduce hardware such as a monitor, hard drive, or visual display of data to a screen.

Furthermore, claims 79, 80 and 81 recite "for use in conjunction with" which is an intended use and not a positive limitation. The phrase "for use in conjunction with" does not clearly embody a computer readable medium or program product. See MPEP

Section 2106 which points to additional section 2111.04. The removal of "for use in" is suggested.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

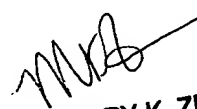
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MARY K. ZEMAN
PRIMARY EXAMINER
